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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,977	06/22/2001	Yung-Feng Wang	3158/OJ463	8076

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EXAMINER

RYMAN, DANIEL J

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,977

Applicant(s)

WANG ET AL.

Examiner

Daniel J. Ryman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 18 January 2006 have been fully considered but they are not persuasive. On pages 6-7 of the Response, Applicant asserts that Tayloe does not disclose a "stored priority table contain[ing] prioritized arrangement of cooperation between the SIM cards and their respective compatible service providers." Examiner agrees, which is why Examiner combined Tayloe with Applicant's admitted prior art (AAPA). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Simply, it is the combination of Tayloe and AAPA, not Tayloe individually, that teaches storing a prioritized arrangement of cooperation in the table rather than a prioritized arrangement of service providers.

2. On page 7 of the Response, Applicant additionally asserts that "Tayloe is different from the present application" since in the present application "the telephone does not select the service provider ("best network") and the suitable SIM card is switched according to the priorities." Again, Examiner agrees, which is why Examiner combined Tayloe with AAPA. To reiterate, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

3. On page 7 of the Response, Applicant proceeds to assert that AAPA "does not disclose switching to one of the SIM cards according to the priorities." While Examiner agrees that

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AAPA does not disclose switching between multiple SIM cards in a single phone according to priorities, Examiner disagrees that AAPA does not teach switching SIM cards according to priorities. AAPA explicitly teaches that a user will switch out phone cards according to cost concerns when traveling between different networks to ensure that the phone operates with the SIM that offers the lowest cost services on any given network (page 1, line 28-page 3, line 2). For example, AAPA teaches “it is important to switch to a SIM card achieving the least expensive connection path to the destination when making a call” (page 2, lines 6-8). As such, Examiner asserts that AAPA discloses “switching to one of the SIM cards according to the priorities.” However, AAPA does not teach having a single phone containing multiple SIM cards perform the switching.

4. Simply, Examiner asserts that Tayloe teaches a phone containing multiple SIM cards, where the multiple SIM cards use a priority system to connect to a “best network,” such that the single phone has multiple SIM cards connected to a given network at any point in time. AAPA teaches that there are instances in which one SIM card will offer a much lower cost connection than another SIM card, such that “it is important to switch to a SIM card achieving the least expensive connection path to the destination when making a call” (page 2, lines 6-8). However, AAPA does not teach using a single phone containing multiple SIM cards to perform the switching. Therefore, Examiner maintains that Tayloe and AAPA, in combination, teach using a single phone containing multiple SIM cards to switch between SIM cards that can connect to a given network in order to achieve a lowest cost connection for the phone on a particular network.

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5. Applicant's further argues on pages 7-8 that the cited prior art does not render obvious the limitations of the dependent claims due to the above alleged deficiencies. Examiner maintains that the cited prior art is not deficient, as outlined above.

6. In view of the foregoing, Examiner maintains that the claims are obvious in view of the cited prior art.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4-9, 11, 12, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tayloe (USPN 5,987,325) in view of Applicant's Admitted Prior Art.

9. Regarding claims 1, 8, and 16, Tayloe discloses a method and apparatus for switching between multiple SIM cards within a telephone, the method comprising the steps of and the apparatus comprising means for: storing a plurality of internal ID codes, each of which identifies a direct service provider of one of the SIM cards ("data for more than one providing network") (col. 4, lines 26-47); storing a priority table ("best" network), comprising priorities of cooperation for the SIM cards with the compatible service provider (col. 4, lines 26-47) where the phone will rank networks depending on factors such as "personal preference, cost, reliability, perhaps throughput . . . , and perhaps user priority" to pick the "best" network based on the capabilities of the SIM cards; receiving an ID code identifying one of the service providers (col. 4, lines 26-47) where this is inherent since the phone will only connect to networks for which it

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has received an ID code; comparing the received ID code to each of the internal ID codes (col. 4, lines 26-47) where this is inherent since the phone will only connect to networks with which it is capable of communicating; and switching to one of the SIM cards (col. 5, lines 10-15 and col. 5, lines 25-30).

Tayloe does not expressly disclose switching to one of the SIM cards according to the priorities when the service provider identified by the received ID code is recognized as the compatible one of the SIM card switched to, identified by the corresponding internal ID code. Rather, Tayloe discloses that the multiple SIM cards are connected simultaneously to either a single network or different networks such the user can choose between the different SIM cards (col. 5, lines 10-15 and col. 5, lines 25-30). However, Tayloe does disclose prioritizing the networks (col. 4, lines 26-47) and having the phone automatically make selections of the best network (col. 4, lines 26-47) and security mode within a selected SIM card (col. 5, lines 25-31). Applicant teaches as prior art that users will select between SIM cards in order to select a SIM card with which the user can make the least expensive call (page 1, line 28-page 3, line 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow the system to switch to one of the SIM cards according to the priorities in order to allow the user to use the SIM card that will provide the “best” service for the call.

10. Regarding claims 2 and 9, Tayloe in view of Applicant discloses that the internal ID codes further identify a provider compatible with the direct providers of the SIM cards (Tayloe: col. 4, line 56-col. 5, line 9).

11. Regarding claims 4 and 11, Tayloe in view of Applicant discloses that the priorities correspond to fee rates under the cooperation for the SIM cards with the compatible service

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provider and the fee rate of the cooperation for the SIM card switched to with the compatible service provider is the lowest (Taylor: col. 4, lines 26-47 and Applicant: page 1, line 28-page 3, line 2).

12. Regarding claim 5, Taylor in view of Applicant do not expressly disclose activating a Standby mode on the telephone; however, Examiner takes official notice that activating a Standby mode on a telephone is well-known in the art as a means for conserving power. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to activate a Standby mode on the telephone in order to conserve power.

13. Regarding claims 6 and 12, Taylor in view of Applicant discloses that the switching of the SIM cards is activated immediately after the telephone is turned on (Taylor: Fig. 3 and col. 4, lines 20-47).

14. Regarding claims 7 and 14, Taylor in view of Applicant suggests that the switching of the SIM cards is activated immediately after a Send key of the telephone is pressed. Taylor discloses selecting a SIM card before a call is placed (col. 5, lines 25-31). Taylor in view of Applicant suggest automatically making the selection of the SIM card based upon priorities (Taylor: col. 4, lines 26-47 and Applicant: page 1, line 28-page 3, line 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to switch to the SIM card after the Send key is pressed in order to allow the system to automatically select the appropriate SIM card at the time a call is placed.

15. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor (USPN 5,987,325) in view of Applicant's Admitted Prior Art as applied to claim 8 above, and further in view of Phillips et al. (USPN 6,400,965).

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16. Regarding claim 13, Tayloe in view of Applicant does not expressly disclose that the switch is a multiplexer. Phillips teaches, in a cellular phone handset, using a multiplexer as a switch in a SIM card reader in order to eliminate the cost of spring contacts (col. 5, lines 43-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a multiplexer as the switch in order to eliminate the cost of spring contacts.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rhawi (USPN 6,829,472), see entire document which pertains to prioritizing networks for a mobile phone and Molne (USPN 5,999,811), see entire document which pertains to prioritizing networks for a mobile phone.

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Ryman whose telephone number is (571)272-3152. The examiner can normally be reached on Mon.-Fri. 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (571)272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 Daniel J. Ryman
Examiner
Art Unit 2665


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